

Serial No. 10/708,888  
Filed: 03/30/2004  
Page 2 of 5

Examiner: John A. Ricci  
Group Art Unit: 3714

#### REMARKS

Claims 1-46 were in the application as filed. The Examiner has required restriction between allegedly patentably distinct Species A (Figures 1-26) and Species B (Figures 27-32). The Examiner asserts that claims 1, 18-21, 39, 40, and 43-45 are generic. In restricting the Applicant's application to one of the above-identified groups, the Examiner has made too narrow a restriction requirement. Applicant respectfully requests that the Examiner consider the withdrawal of the restriction requirement in light of the arguments advanced herein. Alternatively, Applicant provisionally elects the claims of Species A with traverse.

#### Restriction Requirement

The Examiner has required restriction between alleged Species A (Figures 1-26), which comprises a paintball gun-mounted magazine having an automatically reclosable hinged cover, and a paintball storage canister having an automatically reclosable hinged cover adapted to open and open the magazine cover when the storage canister engages the magazine opening, and alleged Species B (Figures 27-32), which comprises a paintball gun-mounted magazine having an automatically reclosable stretched fabric cover, and a paintball storage canister having an automatically reclosable hinged cover comprising alternately one or two gates adapted to open when the storage canister is inserted into the magazine opening. The restriction requirement is respectfully traversed as being improper.

Restriction may be required if two or more "independent and distinct" inventions are claimed in one application. 35 U.S.C. §121. Alleged Species A and B have the unifying concept of a paintball gun magazine having an opening with an automatically reclosable cover which is opened for delivery of paintballs into the magazine from an automatically reclosable storage canister when the storage canister is inserted into the opening in the magazine. Species A and B are not independent and distinct and, thus, should not be subject to restriction.

Serial No. 10/708,888  
Filed: 03/30/2004  
Page 3 of 5

Examiner: John A. Ricci  
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According to the Manual of Patent Examination Procedure §802.01, "independent" means that there is "no disclosed relationship between the two or more subjects disclosed, that is, they are unconnected in design, operation, or effect." "Distinct" means that "two or more subjects as disclosed are related, for example, as a combination and a part (subcombination) thereof, process and apparatus for its practice, process and product made, etc., but are capable of separate manufacture, use, or sale as claimed, and are patentable over each other."

Alleged Species A and B are dependent, not independent, because they both have the same design, mode of operation, function, and effect, and are therefore related. Both Species comprise a canister comprising an elongated reservoir, an end cover comprising a pivoting gate biased to a normally closed position, which is urged to an open position through engagement with an opening in a paintball magazine. Both Species comprise a paintball magazine having an opening with a cover biased to a normally closed position, which is opened by insertion of the canister gate in the opening. The only substantive difference between the Species is in the magazine cover, which is a pivoting cover in one embodiment and a stretchable fabric in the other embodiment. The basic structure and operation of the canisters, and the interaction between the canisters and the magazine opening, are the same in either case.

Alleged Species A and B are not distinct because they are not capable of separate manufacture, use, or sale as claimed. The two Species comprise paintball storage canisters and magazine opening covers that are substantively identical. The canisters have gates that are biased to a normally closed position, and that are opened when the canister is disposed into the magazine opening. The magazine openings have a cover that is biased to a normally closed position, and that is opened when the canister is disposed into the magazine opening.

Moreover, a search of the prior art would not be duplicative and Applicant is at a loss as to how the Examiner would be burdened by having to examine all the groups of claims since they relate to such intertwined subject matter.

Serial No. 10/708,888  
Filed: 03/30/2004  
Page 4 of 5

Examiner: John A. Ricci  
Group Art Unit: 3714

As the Examiner is undoubtedly aware, 37 CFR 1.141(a) states:

Two or more independent and distinct inventions may not be claimed in one national application, except that more than one species of an invention, not to exceed a reasonable number, may be specifically claimed in different claims in one national application, provided the application also includes an allowable claim generic to all the claimed species and all the claims to species in excess of one are written in dependent form (§ 1.75) or otherwise include all the limitations of the generic claim.

*See, also, Manual of Patent Examining Procedure, §§806.04(a), 806.04(h).* Thus, 37 CFR 1.141(a) recognizes that a single application can properly include claims to a reasonable number of species greater than one provided the application includes an allowable generic claim from which the species claims depend. This is precisely the situation with respect to the Application at issue. While no decision has yet been made concerning the allowability of the generic claims, the species claims must be examined if a claim generic to the species is allowed. *See, MPEP §809.02(c).*

There is good reason to maintain all species claims in the application for examination pending allowance of one or more of the generic claims. The number of species, i.e. two, is not unreasonable. Applicant submits that there is a high likelihood that one or more of the generic claims will be allowed. Applicant would withdraw essentially only four claims directed to a single species pursuant to the restriction requirement. Thus, the burden of maintaining the claims in the application is negligible, and far outweighed by the burden of continuing examination of the withdrawn claims after allowance of one or more of the generic claims. Nevertheless, Applicant confirms a provisional election with traverse of alleged Species A (Figures 1-26).

#### **Election of Species**

Applicant provisionally elects alleged Species A (Figures 1-26), claims 1-10, 14-16, 18-30, 34-36, and 38-46, with traverse.

Serial No. 10/708,888  
Filed: 03/30/2004  
Page 5 of 5

Examiner: John A. Ricci  
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The Examiner has identified claims 1, 18-21, 39, 40, and 43-45 as generic. As the Examiner is undoubtedly aware, MPEP §809.02(c) states:

(B) When a generic claim is subsequently found to be allowable, and not more than a reasonable number of additional species are claimed, treatment shall be as follows:

(1) When all claims to each of the additional species are embraced by an allowable generic claim as provided by 37 CFR 1.141, applicant must be advised of the allowable generic claim and that **claims drawn to the nonelected species are no longer withdrawn** since they are fully embraced by the allowed generic claim. (Emphasis added.)

Upon the allowance of one of the generic claims, Applicant will be entitled to consideration of dependent claims 11-13, 17, 31-33, and 37 as drawn to a species which is non-elected as a result of the restriction requirement. *See, 37 CFR 1.146.*

#### CONCLUSION

If there are any outstanding issues which the Examiner feels may be resolved by way of telephone conference, the Examiner is cordially invited to contact the undersigned to resolve these issues. Early notification of allowability is respectfully requested.

Respectfully submitted,

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